

REMARKS UNDER 37 CFR § 1.116

Formal Matters

Claims 15, 26, 29-30 and 33-34 are pending after entry of the amendments set forth herein.

Claims 15, 17, 19, 26-27, 29-30 and 33-34 were examined. Claims 15, 17, 19, 26-27, 29-30 and 33-34 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

In the Official Action of May 9, 2003, the Examiner rejected claims 15, 26, 29 and 33 under 35 U.S.C. Section 102(b) as being clearly anticipated by Takahashi et al. The Examiner indicated that the language in the claims stating that the device is adapted to fix a portion of a heart is intended use and not sufficient to define over Takahashi et al. The Examiner took the position that the forceps for semiconductor silicon wafers which is disclosed by Takahashi et al. is capable of grasping the heart and being tied off to fix the heart. Applicants note that the rejected claim language does not recite "capable of grasping the heart", but rather that the claimed invention is "adapted to contact the portion of the beating heart". The silicon wafer forceps of Takahashi et al. are not adapted to contact a portion of a beating heart, let alone stabilize a beating heart. To further emphasize this point, Applicant have amended claim 15 to recite a surgical instrument, to clearly define over the semiconductor tool disclosed by Takahashi et al.

The Examiner further argued that Takahashi et al. discloses a suction port, which the Examiner identified as recess 35, a suction line 33 and a suction aperture, which the Examiner defined as the opening in element 32 shown to the right in Figures 3 and 4. The opening in element 32 is described at column 4, lines 60-65 as connection hole 37, which is formed in connection tube 36. The ventilation tube 33 is connected to connection tube 36 via threads. Although Applicants disagree that Takahashi et al. describes a suction aperture, as claimed, Applicants have amended the claims above to even more clearly distinguish this feature by noting that the claimed suction aperture has a cross-sectional area that is smaller than the cross-sectional area of the suction line with which it connect. Takahashi et al. clearly fails to disclose or suggest such an arrangement.

Further, it is noted that Takahashi et al. clearly fails to meet the claims as amended to recite a plurality of ports, since Takahashi et al. does not disclose or suggest a plurality of ports.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 15, 26, 29 and 33 under 35 U.S.C. Section 102(b) as being clearly anticipated by Takahashi et al., as being clearly inappropriate.

Claims 17, 19 and 27 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Takahashi et al. in view of Nishiguchi et al. The Examiner asserted that it would have been obvious to modify Takahashi et al. to use a plurality of ports as taught by Nishiguchi et al. to protect the device being picked up. Applicants respectfully disagree. Since Takahashi does not use a single port, but rather a broad recess 35 and an adsorptive member, there would be no suggestion, absent that of hindsight gained through reading the present specification and claims, to modify the device of Takahashi et al. to take on a configuration such as disclosed by Nishiguchi et al. Further, even if such a combination were proper, which Applicants respectfully submit it is not, the resulting combination would still not cure the defects of Takahashi et al. as described above with regard to the rejection under 35 U.S.C. Section 102(b).

Further, since claims 17, 19 and 27 have been canceled without prejudice above, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 17, 19 and 27 under 35 U.S.C. Section 103(a) as being unpatentable over Takahashi et al. in view of Nishiguchi et al., as being moot. As to the independent claims 15 and 26, neither Takahashi et al., nor Nishiguchi et al., whether taken alone or combined in an proper manner, disclose or suggest a plurality of ports connected to a common vacuum conduit or line wherein each port is connected to the vacuum by way of an aperture having a smaller cross-sectional area than either the vacuum line or the port.

The Examiner further rejected claims 17, 19 and 27 under 35 U.S.C. Section 103(a) as being unpatentable over Palmer et al. in view of Nishiguchi et al. Palmer et al. discloses a battery operated hand held vacuum handling device for picking up semiconductor wafers. Palmer et al. does not disclose a surgical instrument. The disclosure of Palmer et al. suffers from all of the same deficiencies in meeting the present claims that were discussed above with regard to Takahashi et al. Even if the proposed combination of Palmer et al and Nishiguchi et al. were proper, which Applicants respectfully submit it is not, the resulting combination would still not cure the defects of Palmer et al. as described above with regard to Takahashi et al..

Further, in view of the cancellation of claims 17, 19 and 27 without prejudice, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 17, 19 and 27 under 35 U.S.C. Section 103(a) as being unpatentable over Palmer et al. in view of Nishiguchi et al., as being moot.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-003CON3.

Respectfully submitted,
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Date: _____

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By: _____



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